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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/535,536

Filing Date: May 18, 2005

Appellant(s): AZAR ET AL.

Paul Fenster
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 July 2008 appealing from the Office action mailed 02 January 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

D. GROUND OF REJECTION 4 (CLAIMS 7 AND 11) Claims 7 and 11

stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11,571,753.

GROUNDS OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 7 and 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11,571,753.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 92/16338 A1	KELMAN	10-1992
5,065,515	IDEROZA	11-1991
3,045,345	BERMINGHAM	07-1962

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 10, 11, 13, 15 and 17 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kelman (International Publication No. WO/92/16338).

Kelman discloses a hand-held hair cutting apparatus comprising a structure adapted for contacting an area of skin having hair and a method of collecting cut hair, the apparatus comprising: a heated elongate element (laser beam 18; Abstract; vaporize and carbonize; page 5, lines 18-24) heated to a temperature sufficient to cut hair, mounted on the structure (via the laser beam generating apparatus 12; and an electrostatically charged element adapted for collecting cut hair (page 6, line 24 – page 7, line 3).

With respect to the limitation of a heated elongated element, Kelman disclose a laser beam (18) that is used to cut hair (Abstract). A laser beam is an elongated beam of light that is amplified by stimulated emission of radiation. Kelman further disclose the hair being vaporized or carbonized at the location of impingement of the laser beam (18) thereon (page 5, lines 18-24). To carbonize hair by a laser beam (18) would involve

a burning/heating since the laser beam (18) light is not carbonizing by a chemical process or by fossilization. Therefore, Kelman fully meets “a heated elongate element heated to a temperature sufficient to cut hair” given its broadest reasonable interpretation.

Kelman further discloses the electrostatically charged element comprising a hair collecting receptacle (inherent in a hair collecting means; page 10, claim 9) and a comb portion (40); including moving the heated elongate element along the surface of the skin of an area from which hair is to be removed by hand (see Figures 1A, 1B, 2A, 3A, 4); and the elongate element being located external to the housing (see Figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kelman (International Publication No. WO/92/16338) in view of Iderosa (U.S. Patent No. 5,065,515).

Kelman discloses all of the limitations of the claimed invention, as previously set forth, except for the heated elongate element being a wire instead of a laser. Iderosa teaches that a heated wire metallic element is an equivalent structure known in the art (Abstract; column 1, lines 62-67; column 2, lines 20-36; column 3, lines 54-61; see Figure 3). Therefore, because these heating means were art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a heating wire for a laser.

Claims 16 and 18-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kelman (International Publication No. WO/92/16338) in view of Bermingham (U.S. Patent No. 3,045,345).

Kelman discloses all of the limitations of the claimed invention, as previously set forth, except for the electrostatically charged element being charged by friction of the element with the skin of a user as it is moved along the skin.

However, an electrostatically charged element being charged by friction as it is moved along the skin is known in the art. Bermingham, for example, teach a shear plate (14) constructed of a dielectric material that is adapted to develop a static electrical charge by friction, a charge is developed and retained therein on being brought into contact with the skin (column 1, lines 14-20; column 2, lines 26-55). Bermingham further

teaches the advantage of such a configuration provides an attracting force for the hairs to be cut and tends to set them into optimum cutting operative movement, thereby improving the operational efficiency of the hair cutting device. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Kelman with the electrostatically charged element being charged by friction as it is moved along the skin of Bermingham in order to provide an attracting force for the hairs to be cut and tends to set them into optimum cutting operative movement, thereby improving the operational efficiency of the hair cutting device.

With respect to the claim 18, 24, 30 and 34, Kelman discloses the apparatus for removing loose hairs (vacuum apparatus 24) being opposite the heated elongate element (laser beam 18) (see Figure 4). Kelman also disclose a comb (40) being constructed as part of the vacuum apparatus (24) which arranges both loose and attached hairs (42). In addition, Kelman discloses an electrostatically charged element may be used instead of the vacuum apparatus (24) for collecting cut hair (page 6, line 24 – page 7, line 3). Such a substitution would be relatively in the same approximate location as the vacuum apparatus (24), therefore, the location of the electrostatically charged element would be approximate the comb (40) as well. Therefore, the electrostatically charged element/comb combination fully meets “a housing adapted for holding by a user wherein the electrostatically charged elongate element comprise an outcropping from the housing” Given its broadest reasonable interpretation.

With respect to the limitations of claims 19, 21, 25, 27, 31 and 33, Kelman discloses the hair cutting apparatus (see Figure 4) being moved along the skin and the

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outcropping (comb 40) being spaced from the heated elongated element (laser beam 18). Bermingham teaches the contacting surface (plate 14) contacting the skin during the shaving process. Since Kelman discloses the electrostatically charged element being opposite the heated elongated element (laser beam 18), as asserted above, and Bermingham teaches the electrical static generating surface being in contact with the skin, Kelman in view of Bermingham fully meets "the apparatus is adapted to be moved along the skin and wherein the outcropping is spaced from the heated elongate element such that the electrostatically charged element contacts the skin after the hair has been cut" Given its broadest reasonable interpretation.

With respect to the limitation of claim 20, 22, 23, 26, 28, 29, 32, 35 and 36, Kelman discloses the electrostatically charged element comprising a hair collecting receptacle (inherent in a hair collecting means; page 10, claim 9) and a comb portion (40) adjacent the electrostatically charged element, as asserted above. Bermingham further teach the electrostatically charging plate (14) being on the contact face of the hair cutting device.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7 and 11 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11,571,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broader in scope than that of the copending application. Therefore, the copending application comprising a blunt debris removal element that would inherently

generate an electrostatic force during operation meets the limitations of the instant application..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(10) Response to Argument

A. GROUND OF REJECTION 4 (CLAIMS 7, 10, 11, 13, 15 AND 17)

A.1 Claim 7 distinguishes over the cited reference

With respect to appellants' argument that laser beam (18) is not an elongated heated element and, furthermore, is not heated and produces heat, due to the physics of the laser beam and how it cuts, the examiner disagrees. Kelman discloses a laser beam (18) that is used to cut hair (Abstract). A laser beam is an elongated beam of light that is amplified by stimulated emission of radiation. Kelman further discloses the hair being *vaporized or carbonized* at the location of impingement of the laser beam (18) thereon (page 5, lines 18-24). To carbonize hair by a laser beam (18) would involve a burning/heating since the laser beam (18) light is not carbonizing by a chemical process or by fossilization. This would require energy being transferred into heat sufficient to cut hair. Furthermore, the laser beam (18) carbonizes the hair due to the heat created by the energy distribution to the higher density properties of the hair compared to its surrounding air. The density of the air surrounding the laser beam (18), which in essence is part of the laser beam (18) is heated as well, due to particle collision with air. Therefore, the laser beam (18) would be hot compared to the air surrounding the

device, and in return heated. In addition, the laser beam (18), with its inclusive surrounding air, is heated and heated to a temperature sufficient to cut hair or the hair would not be cut.

As applicant has noted, Lasers “are composed of electromagnetic energy that heats an object that absorbs it” (page 9, paragraph 3). As the examiner previously asserted the density of the air surrounding the laser beam (18), which in essence is part of the laser beam (18) is heated, due to particle collision with air, therefore, the laser beam (18) would be hot compared to the air surrounding the device, and in return heated. In addition, the laser beam (18) is designated as an element having an extensive length compared to its width, therefore, the laser beam (18) is an elongated element (see Figures 2A-4). Furthermore, the laser beam (18), with its inclusive surrounding air being heated, heats the surrounding air to a temperature sufficient to cut hair as a part of the heated elongated laser beam (18) passes through the hair and impacts the users face or the hair would not be cut.

With respect to appellants’ argument in regard to the limitation of “heated to a temperature sufficient to cut hair”, the examiner asserts the laser beam (18) has heat associated with it due to the particle collision with the air and hair and a “temperature sufficient to cut hair” as being a broad limitation since there are many different kinds of hair to be cut requiring many different temperatures in which the laser beam (18) and its inclusive surrounding air may encompass.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., heated element present when device is not in use) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, Kelman fully meets “a heated elongate element heated to a temperature sufficient to cut hair” given its broadest reasonable interpretation.

A.2 Claim 11 distinguishes over cited reference

With respect to appellants’ argument that Kelman does not anticipate the limitation of “collecting the hair cuttings from the skin of the user with an electrostatically charged element”, the examiner respectfully disagrees. Kelman explicitly discloses the hair being cut from the skin by the elongated heated member (laser 18). The hair being cut derives from the skin and the hair being collected and electrostatically charged is the same hair that was cut from the skin (page 6-7).

In addition, in response to appellants’ argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., to hair cuttings being on the skin before collection) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Similarly, in response to appellants’ argument that the electrostatic apparatus (not shown) would be in the exact same position as the vacuum apparatus (24), the

examiner respectfully disagrees. One cannot assume that the placement of an element in the exact same position as another apparatus is a prerequisite for functionality. It is known to one of ordinary skill in the art that placement of an element within an apparatus to perform a preferred task involves routine skill in the art and experimentation to define the elements' ultimate location. The examiner asserts the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Therefore since the Kelman discloses the hair being cut by laser beam from skin and collected via the electrostatically charged element, Kelman fully meets "collecting the hair cuttings from the skin of the user with an electrostatically charged element" given its broadest reasonable interpretation.

B. GROUND OF REJECTION 2 (CLAIMS 9 AND 14)

With respect to appellants' argument that the examiner has not provided a prima facie case of obviousness since a combination of Kelman and Iderosa would not result in claims 9-14, the examiner respectfully disagrees. The examiner respectfully utilized the determination of obviousness as laid down in *Graham*. Kelman explicitly discloses laser beam (18) cutting hair. Iderosa explicitly teaches the equivalency of a linearly-scanned laser beam and a metallic heating element in the art of a heating element

sufficient to soften hair (Abstract) and appellant agrees (page 13, end of paragraph 4). If the laser beam can be used to cut and soften hair, it is obvious to one of ordinary skill in the art that a metallic heating element that can be heated to a temperature to soften hair can be heated to a temperature to cut hair.

In Iderosa, the examiner provided an equivalency teaching to one of ordinary skill in the art of a “laser beam” and a ceramic or metallic heating element (Abstract) to heat/soften hair. One of the “exemplary rationales” that may support a conclusion of obviousness include is “Simple substitution of one known element for another to obtain predictable Results” (see MPEP § 2143). The examiner provided rationale that the substituted components and their functions were known in the art (Iderosa) as well as asserted, via rejections and arguments, that one of ordinary skill in the art could have substituted one known element (ceramic or metallic heating element) for another (laser beam) and the results of the substitution, utilizing knowledge of one of ordinary skill in the art, would have been predictable as well as provide a predictable result.

In response to appellants’ argument that incorporation of the heating element of Iderosa in Kelman would “destroy the skin”, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

With respect to appellants' argument that Iderosa does not claim a wire, the examiner respectfully disagrees. Iderosa teaches an element (15) made of an electrically resistive material and the element being elongated (column 3, line 52 – column 4, line 18 see Figure 3). There is no recitation to any dimensions, size or heat capacity. It is noted that the features upon which applicant relies (i.e., wire not being a larger element) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, the examiner maintains the equivalency of a linearly-scanned laser beam and a metallic heating element in the art of a heating element sufficient to soften hair as well as cut hair established and further maintains the rejection.

C. GROUND OF REJECTION 3 (CLAIMS 16 AND 18-36)

With respect to appellants' argument in regards to claims 16 and 18-36, the argument(s) were addressed in the argument sections above.

D. GROUND OF REJECTION 4 (CLAIMS 7 AND 11)

With regards to the Obvious Double Patent rejection of claims 7 and 11, the examiner still holds this rejection as proper and, thus, the rejection is maintained. It is noted that applicant did not argue the rejection, therefore, the Board should affirm.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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